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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Edmund Burke

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Serial No. 75614118

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Ezra Sutton, Esq. for Edmund Burke.

Steven R. Berk, Trademark Examining Attorney, Law Office 102 (Thomas Shaw, Managing Attorney).

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Before Chapman, Bucher and Drost, Administrative Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

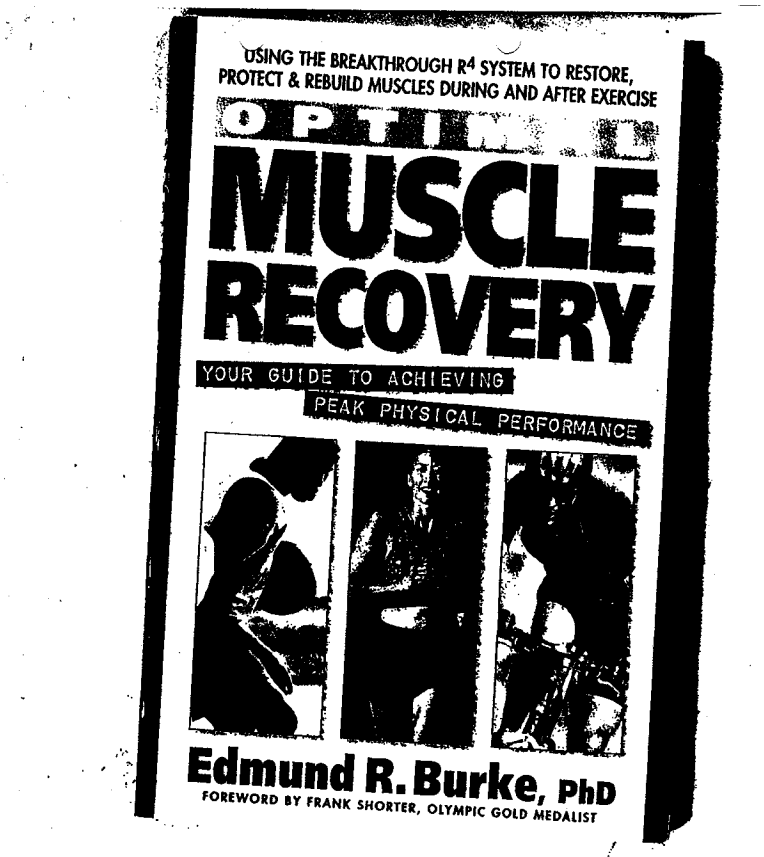
On December 31, 1998, Edmund Burke (applicant) applied to register the mark shown below on the Principal Register:

R4

for "books, pamphlets, and brochures related to a nutritional system and nutritional and dietary supplements for improving muscle performance and speeding muscle recovery" in International Class 16.

The application (Serial No. 75614118) was based on applicant's assertion of a bona fide intention to use the

mark in commerce. Applicant's mark was published for opposition on November 9, 1999. A Notice of Allowance was issued on February 1, 2000. On August 1, 2000, applicant filed a Statement of Use alleging that it had used the mark on the goods anywhere and in commerce at least as early as January 1, 1999. The Statement of Use included the specimen shown below:



The examining attorney[1] then refused to register applicant's term because it fails to function as a mark under the provisions of Sections 1, 2, and 45 of the Trademark Act. 15 U.S.C. §§ 1051, 1052, and 1127. After the examining attorney made the refusal final, applicant filed a notice of appeal.

Discussion

"The question whether the subject matter of an application for registration functions as a mark is determined by examining the specimens along with any other relevant material submitted by applicant during prosecution of the application." In re The Signal Companies, Inc., 228 USPQ 956, 957 (TTAB 1986).

> An important function of specimens in a trademark application is, manifestly, to enable the PTO to verify the statements made in the application regarding trademark use. In this regard, the manner in which an applicant has employed the asserted mark, as evidenced by the specimens of record, must be carefully considered in determining whether the asserted mark has been used *as a trademark* with respect to the goods named in the application.
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> In re Bose Corp., 546 F.2d 893, 192 USPQ 213, 216 (CCPA 1976) (emphasis in original, footnote omitted).

In this case, the specimens consist of the front and back cover of a book. The title of the book is "Optimal

[1] The present examining attorney was not the original examining attorney in this case.

Muscle Recovery – Your Guide to Achieving Peak Physical Performance." The author is identified as Edmund R. Burke, PhD. Above the title, in smaller letters, is the legend "Using The Breakthrough R^4 System To Restore, Protect & Rebuild Muscles During And After Exercise." The back cover contains several paragraphs about the book and the author. The most relevant material is set out below.

> Get ready to revolutionize your training program with *Optimal Muscle Recovery*. You know that it takes hard work and dedication to achieve peak physical performance. But all too often, your efforts are rewarded with sore, fatigued muscles that just aren't up to the challenge of strenuous exercise. Now, in this landmark book, sports scientist Dr. Edmund Burke will show you how to get the most out of your workouts by taking advantage of the one factor that athletes consistently neglect – recovery. Because your muscles adapt to exercise and grow stronger in the interval between exercise sessions, your ability to perform at a high level day after day is limited by how well your body recovers and repairs muscle tissues after strenuous training. The key to maximizing recovery is to consume the right nutrients in the right proportions to ensure your muscles' health and to improve performance. The breakthrough R^4 System provides athletes with simple, practical guidelines to achieve this goal.
>
> Based on the latest research on muscle performance and recovery, the R^4 System goes beyond enhancing performance with sports drinks and energy bars… The R^4 System is an innovative approach to training…

After reviewing the applicant's specimens, the examining attorney concluded that "[a]t most, the use of R^4 provides informational matter about the contents of the book and nothing more. No consumer would see the R^4 as an

indicator of source." Examining Attorney's Brief at 5. In response, applicant argues that "[c]onsumers who view the **R**[4] mark understand that the mark is being used to distinguish [applicant's] goods from those manufactured or sold by others." Applicant's Brief at 3 (emphasis in original).

"The Trademark Act is not an act to register words but to register trademarks. Before there can be registrability, there must be a trademark (or a service mark) and, unless words have been so used, they cannot qualify for registration. Words are not registrable *merely* because they do not happen to be descriptive of the goods or services with which they are associated." In re Standard Oil Co., 275 F.2d 945, 125 USPQ 227, 229 (CCPA 1960) (emphasis in original). "[N]ot every word or combination of words which appears on an entity's goods functions as a trademark." In re Volvo Cars of North America Inc., 46 USPQ2d 1455, 1459 (TTAB 1998).

Thus, merely because an applicant's term appears on specimens for the goods or services, this does not mean that the term itself is used as a trademark or service mark or that purchasers would perceive the term as a mark. Bose, 192 USPQ at 216 (SYNCOM used on instruction sheets did not function as a trademark for loudspeaker systems. "[I]t is quite apparent that, in the specimens of record,

only INTERAUDIO identifies the loudspeaker systems for high-fidelity music reproduction as originating with appellant and distinguishes such goods from those manufactured and sold by others. The mark SYNCOM merely relates to a speaker-testing computer"); In re Compagnie Air France, 265 F.2d 938, 121 USPQ 460, 461 (CCPA 1959) ("Nothing in the advertisement pertaining to the 'SKY-ROOM' identifies the air transportation service of appellant and there is no other evidence which reveals that the public considers 'SKY-ROOM' as an identifying mark of this airline"). In addition, inasmuch as the specimens in this case are the covers of books, it is interesting to note that the Federal Circuit has long held that "this court's case law prohibits proprietary rights for single book titles." Herbko International Inc. v. Kappa Books Inc., 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002). See also In re Cooper, 254 F.2d 611, 117 USPQ 396 (CCPA 1958).

Both applicant and the examining attorney refer to the case of In re Big Stone Canning Co., 169 USPQ 815 (TTAB 1971). In that case, the board found that the term FLASH COOK refers to the method of processing vegetables rather than as a trademark for the cooked vegetables. Applicant argues that his mark refers to a system while the Big Stone case involved a process, and therefore, the case is

distinguishable. However, the case does not stand for the point that terms that identify processes are not registrable. Instead, the case demonstrates that merely using a term on the specimens does not mean that it necessarily serves as a trademark for the goods. Here, the examining attorney did not refuse registration because applicant's term cannot serve as both a name of a system and as a trademark for goods. Applicant's mark was refused registration because the specimens do not show that the term is used as a trademark for the goods applicant has identified in his application.

When we view applicant's specimens of record, the term R^4 does not identify the source of the books. The term always appears in sentences such as "Using the breakthrough R^4 System to restore, protect & rebuild muscles" and "the R^4 System goes beyond enhancing performance with sports drinks." There is no evidence that prospective purchasers would read these sentences or slogans and arrive at the conclusion that applicant's term is a trademark for books, pamphlets, and brochures. The term R^4 refers to a system to enhance peak physical performance that is the subject of a book entitled *Optimal Muscle Recovery.* Even the title of the book, if it is the title of a single work, would not function as a trademark, and applicant's term, which is

embedded in other informational material, would appear to be viewed as referring to the subject matter of the book rather than as a trademark for the goods.

Substitute "Specimen"

On May 20, 2002, along with its appeal brief, applicant submitted an amendment, which it requested to be construed as a request for reconsideration. On November 11, 2000, the prior examining attorney had invited applicant to submit substitute specimens showing use as a *service mark*.[2] However, applicant acknowledges that almost one year later, the examining attorney offered to reconsider the refusal if applicant submitted a substitute specimen showing use as a *trademark*. Applicant's Amendment at 1. Despite the examining attorney's clarification, applicant submitted what it claims is a "printout of his web page showing promotion of the sale of his book and using the **R**[4] mark. This is clearly a proper **service mark**." Amendment at 2 (emphasis in original).[3]

In the order forwarding the appeal brief and amendment to the examining attorney, the board noted that inasmuch

[2] The current examining attorney "believes this to be an error. The prior examining attorney likely meant 'trademark' not 'service mark' in this action." Examining Attorney's Brief at 7.
[3] There were two pages from a website attached to the amendment. We will discuss the more significant page. The second page merely adds that the book will be available March 1, 1999, and lists the stores that will sell the book.

"as the time for filing a request for reconsideration expired on March 12, 2002, such amendment will be construed as a communication." Order dated June 17, 2002 at 1 n.1.[4]

In his appeal brief, the examining attorney objects to this additional specimen on the ground that it was untimely submitted. We agree. "The record in the application should be complete prior to the filing of an appeal. The Trademark Trial and Appeal Board will ordinarily not consider additional evidence filed with the Board by the appellant or by the examiner after the appeal is filed." 37 CFR § 2.142(d). Applicant's "amendment," filed after the time to request reconsideration of the examining attorney's final refusal, is untimely. Applicant's amendment filed in 2002 apparently was motivated by an Office action in 2000 that invited the applicant to submit substitute specimens to show use as a service mark. However, even applicant acknowledges that subsequently the examining attorney clarified this statement to refer to substitute specimens showing trademark use. In any event, applicant could have submitted this amendment much earlier. It is now too late. Accord In re Central Sprinkler Co., 49

[4] The examining attorney's brief was filed on August 9, 2002. Subsequently, the file in this case was apparently lost. We regret the delay in processing this appeal.

USPQ2d 1194, 1195 n.2 (TTAB 1998) ("Although in its brief applicant suggested a suspension and remand to allow the Examining Attorney to consider the additional registrations, it is clear that this evidence could have been submitted much earlier in the prosecution").

In addition to objecting to the "amendment" as untimely, the examining attorney also discussed the new evidence on the merits. For the sake of completeness, we add that the page from the website merely advertises applicant's book for sale. It contains a picture of the front cover of the book that is same as the specimen of record. In addition, it contains a statement similar to the legend on applicant's book cover, i.e., "Dr. Burke shows you how to achieve peak muscle performance using the breakthrough R^4 System to restore, protect and rebuild muscles during and after exercise." At the bottom of the page is a notation that indicates that "$R^{4™}$ System is a trademark of Edmund Burke." The examining attorney points out that "applicant has shown no services whatsoever. The applicant is simply advertising the book through online means." Examining Attorney's Brief at 7. The mere advertising or promotion of one's own goods is not a separate service. In re Dr. Pepper Co., 836 F.2d 508, 5 USPQ2d 1207, 1210 (Fed. Cir. 1987) ("[E]ven though a given

term may function as both a trademark and a service mark, the service must constitute more than mere promotion and advertising of one's own goods"). The substitute specimens offer nothing new other than the fact that applicant advertises his *Optimal Muscle Recovery* book and he uses a notation indicating that he believes the term R^4 is his trademark. As indicated above, merely advertising one's own goods is not a separate service, and the "[u]se of the letters "TM" on a product does not make unregistrable matter into a trademark." In re Remington Products Inc., 3 USPQ2d 1714, 1715 (TTAB 1987). Thus, even if applicant's substitute specimen were properly of record, we agree with the examining attorney that it would not demonstrate that applicant's term functions as a trademark.

Conclusion

In this case, the term R^4 is used to refer to a method to achieve peak physical performance. The evidence does not demonstrate that it functions as a mark to identify and distinguish applicant's books, pamphlets, and brochures from those of others.

Decision: The refusal to register the applied-for term on the ground that it does not function as a mark is affirmed.